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10/785,552

02/24/2004

Edmond J. Cadieux JR.

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12/19/2005

CONNOLLY BOVE LODGE & HUTZ, LLP
P O BOX 2207
WILMINGTON, DE 19899

EXAMINER

MUSSER, BARBARA J

ART UNIT

PAPER NUMBER

1733

DATE MAILED: 12/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/785,552

Applicant(s)

CADIEUX ET AL.

Examiner

Barbara J. Musser

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 6 and 8-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/10/05, 5/17/04.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-5 and 7, drawn to an apparatus for folding and applying onserts to articles, classified in class 156, subclass 443.
 - II. Claim 6, drawn to a lug belt conveyor, classified in class 198, subclass 463.1.
 - III. Claims 8-10, drawn to a method of folding and applying onserts to articles, classified in class 156, subclass 227.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the independent combination claim does not require all the specifics of the subcombination, namely suction rails. The subcombination has separate utility such as a conveyor for envelopes or bottles.
3. Inventions I and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP §

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806.05(e)). In this case the apparatus can be used to practice a different method such as folding fabric and the method can be used with a different apparatus such as having people move the onserts to the applicators rather than using conveyors.

4. Inventions II and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus can be used for a different process such as conveying envelopes, bottles, or boxes.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Richard Beck on 11/22/05 a provisional election was made with traverse to prosecute the invention of group I, claims 1-5 and 7. Affirmation of this election must be made by applicant in replying to this Office action. Claims 6 and 8-10 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-3, 5, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vijuk(U.S. Patent 4,812,195) in view of Bahr et al.(U.S. Patent 4,425,181) and Gunther, Jr. et al.(U.S. Patent 4,071,997).

Vijuk discloses a device for forming onserts for articles wherein a feeder feeds a continuous roll of onserts(30) to a transverse cutter(31) which cuts the web. Each cut section contains multiple labels. A buckle folder(33, 34) folds the cut section into folded joined labels.(Col. 7, ll. 16-61) A longitudinal cutter(53) then cuts the onserts apart, and they are then placed into a box in separate rows.(Figure 1) The reference does not disclose transporting the labels along diverting paths to applying them to spaced apart articles. Bahr et al. discloses taking multiple rows of labels(22), such as those formed by Vijuk and applying them to spaced apart articles(76).(Figures 1 and 3) The references do not disclose a method of moving the individual labels to the articles after they are formed. Gunther, Jr. et al. discloses a conveyor for conveying separate articles from one location to another having pins(lugs, 44) which hold the articles in desired locations on the conveyor.(Figure 5A) It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the device of Vijuk with

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that of Bahr et al. so that the onserts could be formed and applied in a continuous fashion wherein the onserts of Vijuk would be transported to the device for applying the onserts of Bahr et al. rather than to a box, stacks of which would then be removed and placed in magazines for application in Bahr et al. since this would form a continuous process, increasing production and efficiency and to use the conveyor of Gunther, Jr. et al. to move the onserts from the folding and cutting device of Vijuk to the applicator of Bahr et al. since the references do not disclose the type of conveyor used and since the conveyor of Gunther, Jr. et al. is capable of moving paper from one location to another while accurately locating it on the conveyor.(Figure 11) While the references do not specifically disclose transporting the onserts on diverging paths, since they are intended to be applied to articles which are not contacting each other and it is undesirable to have the labels contacting each other even if the articles were in contact as they would have a good chance of overlapping and being bonded to more than one article, one in the art would appreciate that the parts of the onserts would diverge from one another so that the onserts would not overlap during application.

Regarding claim 2, Bahr et al. discloses applying glue to the onserts prior to application to the articles.(Col. 5, ll. 16-20)

Regarding claim 3, while Bahr et al. discloses applying the glue to the onserts, one in the art would appreciate that the glue could instead be applied to the articles since the glue is intended to bond the two items together.

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10. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vijuk, Bahr et al., and Gunther, Jr. et al. as applied to claim 1 above, and further in view of Joice(U.S. Patent 4,275,977).

The references cited above do not disclose suction rail associated with the conveyor belt for holding the onserts between the rails. Joice discloses a device for moving thin articles which includes suction rails(42,44) which hold the article in place on the belt.(Figure 2) It would have been obvious to one of ordinary skill in the art at the time the invention was made to include suction rails in the conveyor used in Vijuk, Bahr et al., and Gunther, Jr, et al. since such suction rails would keep the onserts on the conveyor.

11. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vijuk(U.S. Patent 4,812,195) in view of Bahr et al.(U.S. Patent 4,425,181).

Vijuk discloses a device for forming labels for articles wherein a feeder feeds a continuous roll of labels(30) to a transverse cutter(31) which cuts the web. Each cut section contains multiple labels. A buckle folder(33, 34) folds the cut section into folded joined labels.(Col. 7, ll. 16-61) A longitudinal cutter(53) then cuts the labels apart, and they are then placed into a box in separate rows.(Figure 1) The reference does not disclose transporting the labels along diverting paths to applying them to spaced apart articles. Bahr et al. discloses taking multiple rows of labels(22), such as those formed by Vijuk and applying them to spaced apart articles(76).(Figures 1 and 3) The references do not disclose a method of moving the individual labels to the articles from the folding unit. It would have been obvious to one of ordinary skill in the art at the time

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the invention was made to combine the device of Vijuk with that of Bahr et al. so that the onserts could be formed and applied in a continuous fashion wherein the onserts of Vijuk would be transported to the device for applying the onserts of Bahr et al. rather than to a box, stacks of which would then be removed and placed in magazines for application in Bahr et al. since this would form a continuous process, increasing production and efficiency and to use a conveyor to move the onserts from the folding and cutting device of Vijuk to the applicator of Bahr et al. since conveyors are conventional methods of moving articles from one place to another as shown by Vijuk which uses multiple conveyors to move the onserts from one location to another. While the references do not specifically disclose transporting the onserts on diverging paths, since they are cut from each other they are contacting each other. Since they are intended to be applied to articles which are not contacting each other and it is undesirable to have the labels contacting each other even if the articles were in contact as they would have a good chance of overlapping and being bonded to more than one article, one in the art would appreciate that the parts of the onserts would diverge from one another so that the onserts would not overlap during application.

Conclusion

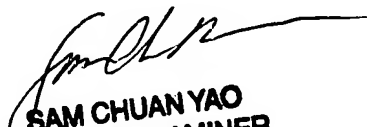
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara J. Musser whose telephone number is (571) 272-1222. The examiner can normally be reached on Monday-Thursday; alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dunn can be reached on (571)-272-1171. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


BJM


SAM CHUAN YAO
PRIMARY EXAMINER